

*SUB*  
wherein, when said pressing force is applied to said elastic body, said elastic body covers all side surfaces of said first laminate.

*B5*  
27. (New) The manufacturing method of laminates according to Claim 1, wherein, when said pressing force is applied to said elastic body, said elastic body covers an upper surface, a lower surface and a side surface of said first laminate.

28. (New) The manufacturing method of laminates according to Claim 27, wherein, when said pressing force is applied to said elastic body, said elastic body covers all side surfaces of said first laminate.—

## R E M A R K S

### I. Introduction

In response to the pending Office Action, Applicants have amended claims 1, 4, 17 and 20 so as to address the rejection thereof under 35 U.S.C. § 112, second paragraph, as well as to further define the subject matter of the invention. Support for the amendment to claim 1 can be found, for example, on page 17, lines 18-27 and page 18, lines 17-20 of the specification. Support for the amendment to claim 20 can be found, for example, in Fig. 12 and the corresponding disclosure. In addition, new

claims 24-28 have been added. Support for new claim 24 can be found on page 17, lines 25-27. Support for claims 25 and 26 can be found in Fig. 1 and the corresponding disclosure, and support for new claims 27 and 28 can be found in Fig. 11 and the corresponding disclosure. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

**II. The Rejection Of The Claims Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-23 were rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and claim the subject matter of the invention. In response to the pending rejection, Applicants have amended each of the claims noted in the pending rejection so as to eliminate the language objected to by the Examiner. Accordingly, it is respectfully submitted that, as amended, all claims are definite and unambiguous, and therefore satisfy the requirements of 35 U.S.C. § 112, second paragraph.

**III. The Rejection Of The Claims In View Of Hass**

Claims 1-6, 9-11, 13 and 17-19 were rejected under 35 U.S.C. § 102 in view of USP No. 5,573,622 to Hass. Claims 7, 8, 14-16 and 20-23 were rejected under 35 U.S.C. § 103 in view of Hass. Applicants respectfully submit that, as amended, the

foregoing claims are patentable over Hass for the following reasons.

**A. Claim 1**

As recited by amended claim 1, the method of the present invention includes maintaining the laminate in a depressurized atmosphere during the first step in which the gas/air is eliminated from the laminate and during the second step during which the pressing force is applied to the laminate. Importantly, by maintaining the laminate in a depressurized state during the pressing process (i.e., second step), gas is prevented from coming back into the laminate during the pressing process. As a result, the method of the present invention produces a high density laminate having an uniform configuration.

Turning to Hass, it is acknowledged in the pending rejection that Hass does not disclose depressurizing the multilayer structure prior to lamination. As such, for this reason alone, it is clear that Hass fails to anticipate amended claim 1, as it is well known that anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

With regard to the rejection under § 103, *Hass does not appear to make any*

***disclosure or suggestion of maintaining the laminate in a depressurized atmosphere prior to and during the pressing process.*** As noted above, it is in-part the maintaining of the laminate in a depressurized state prior to and during the pressing process that provides the improved laminate structure of the present invention, having high density and an uniform configuration.

It is well known that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Moreover, recognizing after the fact that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967).

It is only Applicants' disclosure that discloses maintaining the laminate in a depressurized atmosphere prior to and during the pressing process. Thus, the only motivation of record for the proposed modification of the device of Hass to arrive at the claimed invention is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103.

*Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

Finally, it is noted that reliance upon "general knowledge" (of what is known) to reject claims is not objective evidence that claims as a whole, are obvious within the meaning of 35 U.S.C. § 103. In addition, mere conclusions that various aspects of the claimed invention are obvious does not support a *prima facie* case of obviousness under 35 U.S.C. § 103.

For all of the foregoing reasons, it is respectfully submitted that Hass does not render any of the pending claims obvious.

***B. Claim 20***

As recited by claim 20, the present invention relates to pressing force application equipment comprising a first pressing force application member with an elastic body provided inside of a first rigid body; and a second pressing force application member with an elastic body provided inside of a second rigid body. Importantly, each of the first rigid member and the second rigid member have an air outlet for evacuating gases from within the space encapsulated by the first and second rigid body. As a result, effect evacuation of the gases contained within the space and within the laminate can be obtained. In addition, each of the first and second rigid members have elastic frames

(see, e.g., reference numeral 36 in Fig. 12).

Turning to Hass, as Hass fails to disclose the use of a first and second rigid member, as is acknowledged in the pending rejection, it is also clear that Hass fails to disclose or suggest providing a distinct and separate air outlet for each of rigid member. Furthermore, Hass does not appear to disclose or suggest any structure corresponding to the elastic frame members, recited by amended claim 20.

Thus, as each and every limitation must be disclosed or suggested by the cited prior art in order to establish a *prima facie* case of obviousness (see, M.P.E.P. § 2143.03), it is clear that Hass fails to render the present invention as recited by claim 20, or any claim dependent thereon, obvious.

#### **IV. The Rejection Of The Claims Over Natarajan In View Of Hass**

Claims 1-19 were also rejected under 35 U.S.C. § 103 as being obvious over USP No. 5,759,320 to Natarajan in view of Hass. Applicants respectfully submit that, as amended, the foregoing claims are patentable over the combination of Natarajan and Hass for the following reasons.

Similar to Hass, at a minimum, Natarajan *does not appear to make any disclosure or suggestion of maintaining the laminate in a depressurized atmosphere prior to and during the pressing process.*

Thus, as each and every limitation must be disclosed or suggested by the cited prior art in order to establish a *prima facie* case of obviousness (see, M.P.E.P. § 2143.03), and it is clear that the combination of Natarajan and Hass, at a minimum, fails to disclose or suggest at least the foregoing limitation, it is respectfully submitted that claim 1, and the claims, dependent thereon, are patentable over the combination of Natarajan and Hass.

**V. Request For Notice Of Allowance**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

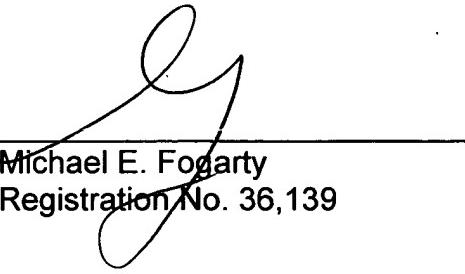
If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

Date: 2/4/03

By:

  
Michael E. Fogarty  
Registration No. 36,139

600 13<sup>th</sup> Street, N.W., Suite 1200  
Washington, DC 20005-3096  
Telephone: (202) 756-8000  
Facsimile: (202) 756-8087

WDC99 713352-1.043890.0522

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Claims 14, 15, 21 and 22, have been cancelled without prejudice.

Claims 1, 4, 17 and 20 have been amended and new claims 24-28 have been added as follows:

1. (Twice Amended) A manufacturing method of laminates comprising:

a first step of preparing a first laminate containing an organic substance by stacking a plurality of [sheet-like] sheet materials, each having asperities on a surface thereof in part; and

a second step of obtaining a second laminate by having said first laminate sandwiched between a rigid body and a preheated elastic body that are located opposite to each other or between opposing preheated elastic bodies and then by having a pressing force applied thereto,

said first laminate being maintained in a depressurized atmosphere during said first step and said second step.

4. (Amended) The manufacturing method of laminates according to Claim 1, wherein [a size of] said elastic bodies [are] have a larger [than a contact] surface area than [between] said first laminate [and said elastic bodies] such that edges of said

elastic bodies extend beyond edges of said first laminate.

17. (Amended) The manufacturing method of laminates according to Claim 1, wherein said [sheet-like] sheet material is formed of a green sheet and an internal electrode layer.

20. (Amended) Pressing force application equipment comprising:  
a first pressing force application member with an elastic body provided inside of a [box-like] first rigid body; and a second pressing force application member with an elastic body provided inside of a [box-like] second rigid body, wherein said first and second pressing force application members are arranged so as to have said elastic body located opposite to each other, and also at least one of said first and second pressing force application member is made movable,

said first rigid body having a first air outlet for evacuating gases and a first elastic frame member disposed on a lower surface thereof, and said second rigid body having a second air outlet for evacuating gases and a second elastic frame member disposed on an upper surface thereof.

Please add new claims 24-28 as follows:

--24. (New) The manufacturing method of laminates according to Claim 1,

wherein maintaining said first laminate in a depressurized atmosphere operates to remove substantially all gas from said first laminate.

25. (New) The manufacturing method of laminates according to Claim 1, wherein, when said pressing force is applied to said elastic body, said elastic body covers an upper surface and a side surface of said first laminate.

26. (New) The manufacturing method of laminates according to Claim 25, wherein, when said pressing force is applied to said elastic body, said elastic body covers all side surfaces of said first laminate.

27. (New) The manufacturing method of laminates according to Claim 1, wherein, when said pressing force is applied to said elastic body, said elastic body covers an upper surface, a lower surface and a side surface of said first laminate.

28. (New) The manufacturing method of laminates according to Claim 27, wherein, when said pressing force is applied to said elastic body, said elastic body covers all side surfaces of said first laminate.--